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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/101,825	07/17/1998	CHRISTIAN GRONHOJ LARSEN	GRONHOJ-LARS	1107

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EXAMINER

HAMUD, FOZIA M

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 07/02/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/101,825

Applicant(s)
Larsen et al

Examiner
Fozia Hamud

Art Unit
1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 2, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22, 24-41, 47, 49-53, 57, 59, 61, 63, and 65-82 is/are pending in the application.
- 4a) Of the above, claim(s) 57 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22, 24-41, 49-53, 61, 63, and 65-82 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02 April 2002 has been entered.

2. Claim 23 is canceled, claims 22, 49 and 76 have been amended, and new claims 80-82 have been added in the amendments field on 07 March 2002 in Paper Nos: 23 and 24 respectively. Thus claims 18-22, 24-41, 47, 49-53, 57, 59, 61, 63, 65-82 are pending. Claims 57 and 59 are withdrawn from consideration as they are drawn to non-elected invention. Claims 18-22, 24-41, 47, 49-53, 61, 63, 65-82 are under consideration by the Examiner.

3. The following previous rejections and objections are withdrawn in light of Applicants amendments filed in Paper Nos:23 and 24 filed on 03/04/02.

(I) The rejection of 18-22, 24-41, 47, and 73-79 under 35 U.S.C. 112, first paragraph for not enabling "all" non-natural amino acids substitutions.

(II) The rejection of claims 49-52, 61 and 63, based on 35 U.S.C. 112, first paragraph, regarding method of preventing.

(III) The new matter rejection against claims 18-22, 24-41, 47 and 73-79.

(IV) The rejection of claim 22 based on 35 U.S.C. 112, first paragraph, for not enabling a peptide amounting up to 30 amino acids.

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Claim objections:

4. Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim rejections-Double patenting

Non-statutory double patenting rejection (obviousness-type)

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4a. Claims 18-22, 24-41, 49-53, 61, 63, 65-79 and 80-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,159,937. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims in the instant application are drawn to a non-naturally occurring peptide amounting 6-20 amino acids, comprising Xa-X4-Xb-X5-Xc-X6, wherein at least one of I-V things is true and a method of treatment using said peptides. Claims 1-39 of U.S. Patent No. 6,159,937 (having same inventors with the instant application), are drawn to a substance which is a polypeptide of amounting 9-20 amino acids comprising the following sequence: X1-X2-X3-Thr-X4-lys-X5-Arg-X6 and a method of treatment using said peptides. Peptides claimed in the instant application and peptides claimed in the patent have the same core structure, namely SEQ ID NO:Nos:1, 19-22.

Instant claims recite I-V conditions, which are not recited in the patented claims, however, the recitation of these conditions does not avoid double patenting issues, because, since the peptides claimed in both the instant application and the patent have same core structure, manipulating and modifying said structure would have been obvious to one of ordinary skill in the art. Thus, instant claims are species to the patented claims which encompass the subject matter of the instant claims. Instant claims are obvious from the patented claims because the patented claims are directed to genus subject matter in which the instant claims are one specific embodiment. The infringement of the instant claims, would also result in the infringement of the broad claims of the patent. Allowance of the pending claims, therefore, would have the effect of extending the enforceable life of the allowed claims beyond statutory limit.

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Conclusion

5. No claim is allowable.

Advisory Information

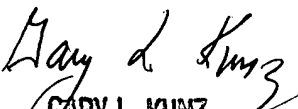
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Thursday from 6:30AM to 4:00PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Fozia Hamud
Patent Examiner
Art Unit 1647
01 July 2002


GARY L. KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600